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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,078

03/31/2004

Takemitsu Honda

17590

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EXAMINER

LEUBECKER, JOHN P

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

05/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/814,078

**Applicant(s)**

HONDA ET AL.

**Examiner**

John P. Leubecker

**Art Unit**

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-16 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                               |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                          | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/31/04 &amp; 5/3/07</u> . | 6) <input type="checkbox"/> Other: _____                                                |

***Election/Restrictions***

1. Applicant's election of Group II in the reply filed on March 5, 2007 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-12 and 15-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Objections***

3. Claims 13 and 20 are objected to because of the following informalities: phrase "which is a current required to operate the function executing unit predetermined time" appears that it should be "which is a current required to operate the function executing unit for a predetermined time". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 13-16 and 20-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding specifically claims 13 and 20, the specification, when describing the third embodiment (to which it appears the claims are directed), fails to mention that the switch (72, starting on page 16, last paragraph) operates so as to “*convert* the first current or the second current to a third current” or “*convert* the first voltage or the second voltage to a third voltage”. Instead, the power converting circuitry is explicitly disclosed as not being required in the third embodiment (note page 17, lines 3-5). The specification only supports that the switch “selectively connects any one of the first power unit and the second power unit to the function executing unit for a predetermined period”.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 13, from which claims 14-16 depend, it is unclear as to whether or not the claim intends the scope of the claim to only cover the power-supply circuit or to the combination of the power supply circuit/in-body information acquiring apparatus. Although it appears to be directed to just the power-supply circuit itself (“A power-supply circuit for...”), the claim

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defines the in-body information acquiring apparatus as having a function executing unit (in preamble) and functionally relates structure of the power-supply circuit (switch) to such function executing unit (lines 10-11). Because of the existence of claim 20 which explicitly and clearly sets forth the combination of power supply circuit and in-body information acquiring apparatus, it will be assumed for examination purposes that claim 13 is intended to be directed only to the power supply circuit and any structure directed to the in-body information acquiring apparatus is not required by the claim and only related as intended use with the power supply circuit. Claim 13 should still be appropriately amended to clearly set forth applicant's intended scope.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Siegel et al. (U.S. Pat. 688,009).

As pointed out above, in numbered paragraph 7, claim 13 is interpreted as being directed only to the power supply circuit. Siegel et al. disclose a power unit that includes a first power unit (a) and a second power unit (b), and a switch (7) which selectively connects any one of the first power unit and the second power unit to a load for a predetermined period (note page 1,

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column 2, lines 71-95). As to claim 14, the first and second power units can include a plurality of cells (note page 1, second column, lines 73-75).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel et al.

Siegel et al. disclose the device described above with respect to claim 13 but fails to disclose any specific type of electric battery. Since the Siegel et al. device is generic to any electric battery cell, use of any specific known electric cells with the Siegel et al. power supply circuit would not be considered invention but a mere obvious selection of one out of many that are known. It would have been obvious to one of ordinary skill in the art to have used any known electric battery cells in the invention of Siegel et al., including SR726SW cells, since use of the Siegel et al. invention would desirably extend the life of such cells (page 1, column 1, lines 18-25).

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12. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaron (U.S. Pat. 7,116,352) in view of Siegel et al.

Yaron discloses an in-body information acquiring apparatus (882, Fig.28) comprising an image sensor (888), a communication unit (898) and a power supply (890). Yaron discloses that the power supply can be a battery (col.29, lines 19-22) which would anticipate a first power unit. Thus, Yaron fails to disclose a second power unit and a switch that selectively connects any one of the first power unit and second power unit to the electrical components (image sensor, communications unit). However, it has long been known in the art that periodic switching between batteries put in parallel greatly extends the life of such batteries (Siegel et al., page 1, column 1, lines 18-25). Since the extension of service life of any battery powered device is desirable, it would be obvious to one of ordinary skill in the art to provide a power supply (such as the switching arrangement as taught by Siegel et al.) that would provide the maximum obtainable life from the battery source. It is logical and would be recognized by one of ordinary skill that use of such power supply as taught by Siegel et al. would allow a reduction in the size of the battery source since prolonged life would allow for smaller capacity (i.e., smaller size) batteries to be used without effecting the desired service life.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dubac et al. (US 2004/0209161)

Gan et al. (U.S. Pat. 6,087,809)

Oliemuller et al. (U.S. Pat. 6,034,443)

LoCascio (U.S. Pat. 5,956,241)

Vail (U.S. Pat. 4,297,590)

Vail (U.S. Pat. 4,101,787)

Bearfield (U.S. Pat. 6,268,711)

Dalton (U.S. Pat. 6,181,067)

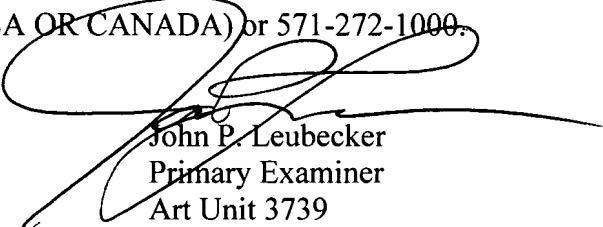
Stewart (U.S. Pat. 5,519,261)

Yokoi et al. (U.S. Pat. 6,855,111)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl